

ELECTION

The Applicants respectfully elect with traverse the claims of Species I, which Applicants believe comprises at least claims 1-7, 9-21, 23-35 and 37-48. Applicants further respectfully submit that at least claims 1-7, 12-14, 16-21, 26-30, 32-35 and 41-48 are generic to Species I, II and III as defined by the Patent Office. Further, claims 9-11, 15, 23-25, 31 and 37-40 are subgeneric, as these claims are believed to read on both Species I and II.

ARGUMENT

The Applicants respectfully traverse the election requirement with respect to election of a single species as defined by the Patent Office. The Patent Office has determined that the "application contains claims directed to the following patentably distinct species of the claimed invention: Species I: drawn from Figures 2A-2C; Species II: drawn from Figure 3; Species III: drawn from Figure 4." As set forth below, the Applicants submit that the restriction requirement is improper and should be withdrawn.

First, the guidelines of the statutes and the rules govern whether a restriction requirement is proper. More specifically, 35 U.S.C. § 121 states in relevant part: "If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." (35 U.S.C. § 121; emphasis added).

Further, 37 CFR 1.142(a) states in relevant part: "If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division)." (37 CFR 1.142(a); emphasis added).

In the context of a restriction requirement, MPEP § 802.01 defines "independent" as follows: "The term 'independent' (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process." (MPEP § 802.01). The MPEP further clarifies the definition of

“independent” by providing examples, stating in relevant part: “An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.” (MPEP § 806.04(A)). In the present case, the differences between the three species set forth by the Patent Office are not nearly as glaring, and are much less bright-lined than the clear examples expressed above in MPEP § 806.04(A).

For example, all three of the species identified by the Patent Office are directed toward disk drives including a positioner that positions a data transducer, the positioner having a magnet assembly and one or more conductors, or methods for positioning a data transducer that include use of a positioner. In accordance with the Figures upon which the Patent Office relies in identifying the various species, each of the conductors has several substantially similar features to one another. As a consequence, the Applicants submit that the different species set forth by the Patent Office are not independent.

In the Restriction Requirement, the Examiner appears to have drawn a distinction between the components illustrated in Figures 2A-2C, 3 and 4 of the present application based upon the shapes, configurations and/or positioning of the magnet assembly and the conductor(s) of the positioner in the disk drive. However, the Patent Office appears to be disregarding that the structural components included in the embodiments illustrated in the Figures are not completely unconnected in design, operation, or effect, as required for a finding of independent inventions.

Moreover, “for purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.” (Guidelines, MPEP 803; emphasis added). The Applicants respectfully submit that the Patent Office has not adequately demonstrated reasons or examples to support its conclusions. Moreover, the Patent Office has not provided any explanation of separate classification or separate status in the art for the various species, or that different fields of search are required to examine the claims of each species together in one application.

Thus, the Applicants respectfully submit that the species identified by the Patent Office (solely by Figure numbers) are not wholly unconnected in design, operation, or

effect. Accordingly, the Applicants submit that examining the embodiments illustrated in Figures 2A-2C, 3 and 4 can potentially be performed together without conducting an additional search. Thus, the restriction requirement should be withdrawn or modified accordingly.

Based on the foregoing, the Applicants assert that the election requirement with respect to the Species is improper, and should be withdrawn. Consequently, the claims of Species I-III, comprising claims 1-48, should be examined together as required by the Species designations of the Patent Office, and pursuant to MPEP 802.01 and 803.